

REMARKS

Claims 14-26 are all the claims pending in the application. Claim 14 has been amended for purposes of further clarity and support for the amendment can be found, for example, in the Examples of the specification.

Entry of the above amendment is respectfully requested.

I. Response to Rejection of Claims 14-26 under 35 U.S.C. §112, second paragraph

Claims 14-26 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting essential steps.

Applicants respectfully traverse the rejection.

Specifically, the Examiner asserts that claim 14 does not recite what the ultraviolet preparation is added to. Claim 14 has been amended to positively recite that the ultraviolet preparation is added to a cosmetic preparation. Accordingly, withdrawal of the rejection is respectfully requested.

II. Response to Rejection of Claims 14-16, 18-21, 25 and 26 35 U.S.C. § 103(a)

Claims 14-16, 18-21, 25 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Baba et al. (US 5,849,272) in view of Bagdi et al. (US 2002/0160023).

Applicants respectfully traverse the rejection.

The Examiner cites Baba as teaching an ultraviolet absorbing composition comprising 4-tert-butyl-4'-methoxydibenzoylmethane (in an amount of 0.1 to 20 wt%) and a diester, where the composition can also include an ester oil, such as pentaerythritol tetra-2-ethylhexanoate (in an amount of 0.5 to 60 weight %). *See* col. 1, lines 13-17; col. 2, lines 15-17 and 30-42; col. 6, lines 45-55; col. 7, lines 5-9; Examples 1-5, 3-1, 3-2, 3-3, 1 and 2. Baba also discloses the use of inorganic pigments, such as titanium dioxide and zinc oxide. *See* Examples 7 and 8.

The Examiner asserts that Baba does not teach the claimed ester compound, and relies on Bagdi as teaching a gallant comprising behenate and eicosanoate, glyceryl behenate/eicosadioate, in an amount of 0.25 to 25%. *See* [0009]-[0010]. The Examiner takes the position that it would have been obvious to use the ester compound of Bagdi because it provides stability and unusual moisturization to a variety of cosmetic products.

Applicants respectfully disagree.

Claim 14 recites that the ultraviolet protective preparation is added to a cosmetic composition. That is, an ultraviolet protective preparation comprising an ester compound, an ester oil, and an ultraviolet protective layer is added to an oil phase.

In contrast, Baba teaches that the composition itself "can be formed as basic cosmetic preparations such as lotion, milky lotion, cream, and oil" and other makeup cosmetic preparations. *See* col. 4, lines 11-24. Therefore, the ultraviolet protective preparation of claim 14 is different from the composition of Baba since the ultraviolet protective preparation of claim 14 is not used as a cosmetic itself.

Thus, Baba does not disclose, teach or suggest preparing an ultraviolet protective preparation prior to formation of the cosmetic or the step of preparing a cosmetic using the ultraviolet protective preparation.

In addition, it is submitted that Baba "teaches away" from the present invention. That is, Baba "teaches away" from, for example, the use of glyceryl tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate. In Table 1, at column 9 of Baba, Sample No. 1-3 to 1-5 use glyceryl tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate. Baba states that these Samples exhibited stickiness, thereby yielding unfavorable feel of use. *See* col. 9, lines 58-60.

Moreover, it is respectfully submitted that there is no motivation to combine Baba and

Bagdi. Specifically, an object of Baba is from that of Bagdi, and thus one of ordinary skill in the art would not be motivated to combine the references.

Even if there were some motivation, it is submitted that the combination of the references would not result in the present invention since neither reference teaches nor suggests adding an ultraviolet protective preparation to an oil phase.

For at least the foregoing reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Moreover, it is respectfully submitted that the claimed invention provides unexpectedly superior results. Although the Examiner asserts that the Declaration is not convincing because of the change in claims from product to process claims, it is submitted that the difference in process imparts the superior properties to the product, i.e., cosmetic.

Baba does not disclose, teach or suggest the effects of the present invention. As demonstrated in the Declaration submitted on August 4, 2009, Example 16 produced by adding the ultraviolet protective preparation comprising an ester compound, an ester oil, and an ultraviolet protective powder to an oil phase has superior effects (e.g., dispersibility in an oil phase, transparent feel, and extension) compared to Comparative Example 36 produced by adding an ester compound, an ester oil and an ultraviolet protective powder separately to an oil phase.

In view of the above, it is respectfully submitted that claim 14 is patentable over the cited art.

In addition, claims 15-16, 18-21, 25 and 26 depend from claim 14, and thus it is submitted that these claims are patentable for at least the same reasons as claim 14.

Accordingly, withdrawal of the rejection is respectfully requested.

III. Response to Rejection of Claims 17 and 22-24 under 35 U.S.C. § 103(a)

Claims 17 and 22-24 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Baba in view of Bagdi and in further view of Miyoshi et al. (US 5,968,531).

Applicants respectfully traverse the rejection.

Claims 17 and 22-24 depend from claim 14, and thus it is submitted that these claims are patentable for at least the same reasons as claim 14.

Accordingly, withdrawal of the rejection is respectfully requested.

IV. Conclusion

In view of the above, reconsideration and allowance of claims 14-26 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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